HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P. O. Box 272400
Fort Collins, Colorado 80527-2400

PATENT APPLICATION

ATTORNEY DOCKET NO. 10019418-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

Inventor(s): Eric Gentry et al.

Confirmation No.: 2230

Application No.: 09/943,875

Examiner: Van H. Nguyen

Filing Date: Aug. 31, 2001

Group Art Unit: 2126

Title: System And Method For Providing Hardware Driver Installation

Mail Stop Appeal Brief-Patents
Commissioner For Patents
PO Box 1450
Alexandria, VA 22313-1450

TRANSMITTAL OF APPEAL BRIEF

Sir:

Transmitted herewith is the Appeal Brief in this application with respect to the Notice of Appeal filed on May 4, 2005.

The fee for filing this Appeal Brief is (37 CFR 1.17(c)) $500.00.

(complete (a) or (b) as applicable)

The proceedings herein are for a patent application and the provisions of 37 CFR 1.136(a) apply.

( ) (a) Applicant petitions for an extension of time under 37 CFR 1.136 (fees: 37 CFR 1.17(a)-(d) for the total number of months checked below:

( )	one month	$120.00
( )	two months	$450.00
( )	three months	$1020.00
( )	four months	$1590.00

( ) The extension fee has already been filled in this application.

(X) (b) Applicant believes that no extension of time is required. However, this conditional petition is being made to provide for the possibility that applicant has inadvertently overlooked the need for a petition and fee for extension of time.

Please charge to Deposit Account 08-2025 the sum of $500.00. At any time during the pendency of this application, please charge any fees required or credit any over payment to Deposit Account 08-2025 pursuant to 37 CFR 1.25. Additionally please charge any fees to Deposit Account 08-2025 under 37 CFR 1.16 through 1.21 inclusive, and any other sections in Title 37 of the Code of Federal Regulations that may regulate fees. A duplicate copy of this sheet is enclosed.

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OR

(X) I hereby certify that this paper is being transmitted to the Patent and Trademark Office facsimile number (703) 872-9306 on Jul. 5, 2005

Number of pages: 15

Respectfully submitted,

Eric Gentry et al.

By _____

Steven R. Ormiston

Attorney/Agent for Applicant(s)

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Attorney/Agent for Applicant(s)

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Date of Deposit: July 5, 2005
Typed or printed name: Tanya E. Paulin
Signature:

ATTORNEY DOCKET NO. 10019418-1

IN THE
UNITED STATES PATENT AND TRADEMARK OFFICE

INVENTOR(S): Eric Gentry et al.

SERIAL NO.: 09/943,875 **GROUP ART UNIT:** 2126

FILED: August 31, 2001 **EXAMINER:** V. Nguyen

TITLE: System And Method For Providing Hardware Driver Installation

APPELLANTS'/APPLICANTS' OPENING BRIEF ON APPEAL

1. REAL PARTY IN INTEREST.

The real party in interest is Hewlett-Packard Development Company, LP, a limited partnership established under the laws of the State of Texas and having a principal place of business at 20555 S.H. 249 Houston, TX 77070, U.S.A. (hereinafter "HPDC"). HPDC is a Texas limited partnership and is a wholly-owned affiliate of Hewlett-Packard Company, a Delaware Corporation, headquartered in Palo Alto, CA. The general or managing partner of HPDC is HPQ Holding, LLC.

2. RELATED APPEALS AND INTERFERENCES.

There are no other appeals or interferences known to Appellants, Appellants' legal representative or the Assignee which will affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

3. STATUS OF CLAIMS.

Claims 1-16 and 19-36 are pending. The rejections of all pending claims are appealed.

4. STATUS OF AMENDMENTS.

No amendments were filed after the final action.

5. SUMMARY OF CLAIMED SUBJECT MATTER.

Claim 1 is directed to a driver install system that includes means for determining if the hardware device is connected to the computer system (Fig. 2, driver installer 150; Fig. 6B, step 161; Specification, page 18, lines 3-4), means for instructing a user to connect the hardware device if it is determined that the hardware device is not connected to the computer system (Fig. 2, driver installer 150; Fig. 6B, steps 162-163; Specification, page 18, lines 4-8), and means for installing a driver for the hardware device if it is determined that the hardware device is connected to the computer system (Fig. 2, driver installer 150; Fig. 6B, step 166; Specification, page 18, lines 12-13).

Claims 9, 19 and 27, which are method, computer medium and system (without means plus function elements) counterparts to the system of Claim 1, respectively, recite similar limitations.

Claim 35 is directed to a method for installing a device driver that includes:

determining if an operating system on the computer includes a Windows installer service (Fig. 6B, step 152; Specification, page 17, lines 5-7);

if it is determined that the operating system does not include a Windows installer service, then removing any driver for the device provided by the operating system and setting up the operating system to use a driver provided with the device (Fig. 6B, steps 152, 153 and 154; Specification, page 17, lines 8-14);

if it is determined that the operating system includes a Windows installer service, then updating any driver for the device associated with the Windows installer service with a driver provided with the device (Fig. 6B, steps 152, 156 and 157; Specification, page 17, lines 17-24)[1];

determining if the hardware device is connected to the computer (Fig. 6B, step 161; Specification, page 18, lines 3-4);

[1] There is an obvious error at page 17, line 17 of the Specification. Consistent with the decision "Yes" between steps 152 and 156 in Fig. 6B, Page 17, lines 17 should read "the operating system is not Windows 98...."

if it is determined that the device is not connected to the computer, then instructing a user to connect the hardware device to the computer (Fig. 6B, steps 162-163; Specification, page 18, lines 4-8); and

If it is determined that the device is connected to the computer, then installing the driver provided with the hardware device (Fig. 6B, step 166; Specification, page 18, lines 12-13).

Claim 36, which is a computer medium counterpart to the method of Claim 35, recites similar limitations.

6. GROUNDS FOR REJECTION TO BE REVIEWED.

A. There is nothing in Fleming (6530018) that suggests instructing a user to connect the hardware device if the device is not already connected (Claims 1-16 and 19-36).

B. Edelstein (6378128) does not teach removing a driver if it is determined the operating system does not include a Windows Installer, or updating a driver if it is determined that the operating system does include a Windows Installer (Claims 35 and 36).

7. ARGUMENT.

A. Ground For Rejection A (Claims 1-16 and 19-36) – There is nothing in Fleming that suggests instructing a user to connect the hardware device if the device is not already connected.

Claims 1-34 were rejected under Section 103 as being obvious over Fleming (6530018) (Claims 1-5, 8-13, 16, 19-22, 25-30 and 33-34) or Fleming in view of Nykanen (6574678) (Claims 6-7, 14-15, 23-24 and 31-32). Claim 1 is directed to a system that includes a means for instructing a user to connect the hardware device if it is determined that the hardware device is not connected to the computer system. The Examiner acknowledges that Fleming does not teach this limitation. In support of the rejection of Claim 1, however, the Examiner asserts that:

> "It would have been obvious to one of ordinary skill in the art to have also included the step of instructing a user to connect the hardware device if it is determined that the hardware device is not

> connected to the computer system. By implementing this step, the user will be prompted to connect a hardware device to the system when they want to install a driver for the hardware device." Office Action mailed January 5, 2005, page 3.

The Examiner's assertion is not sufficient to support the rejection. The advantage asserted by the Examiner as the motivation to modify Fleming (the user will be prompted to connect a hardware device to the system when they want to install a driver for the hardware device) is self-evident from the claim elements. Indeed, it is simply a restatement of the claim elements – "a hardware driver install system" that includes "means for instructing a user to connect the hardware device" and "means for installing a driver." Of course the claimed invention has the advantage of prompting the user to connect the hardware device when they want to install the driver because that's what Claim 1 says.

Obviousness can only be established by modifying the teachings of the prior art where there is some teaching, suggestion, or motivation to do so found either in the reference or in the knowledge generally available to one of ordinary skill in the art. MPEP 2143. While it may be true that an advantage of the modification may indicate the required motivation, that advantage must be recognized in the prior art or drawn from a convincing line of reasoning based on established scientific principles or legal precedent. MPEP 2144. It is impermissible for the Examiner to look to the Applicants' own teachings for the motivation to modify. MPEP 2142.

Fleming detects the presence of a hardware device connected to the system: "the system starts by detecting the presence of device 102 within computer system 108 (step 302)." Fleming, column 4, lines 57-58. Fleming clearly contemplates detecting a device that has already been connected. That is to say, Fleming does not ***determine if*** any particular device is present. Rather, Fleming ***detects that*** the device is present. Quite logically, therefore, Fleming makes no provision for prompting the user to connect a device if the device is not detected as already being present on the computer system. In Fleming, a device that is not detected is irrelevant – Fleming has no interest in any device that is not already connected to the system.

Claim 1, by contrast, focuses on getting the target device connected if it is not already connected. Claim 1, therefore, includes a means for determining if the

device is connected and a means for instructing the user to connect the device if it is determined that the device is not already connected.

It is axiomatic, as the Examiner correctly notes, that the main purpose of a detection mechanism is to detect the presence of a device (Office Action, page 8). After all, that is what a detector does -- it detects things. One might also goes so far as to say, as the Examiner does, that the main purpose also includes taking "appropriate action" if a device is not detected, but only if doing nothing is deemed an appropriate action. Doing nothing is, after all, the only "appropriate action" that can be reasonably be attributed to Fleming in the event a device is not detected because Fleming is completely silent on what happens if a device is not detected -- Fleming's system STARTS when the device is detected. Doing nothing is the only "appropriate action" that might reasonably be deemed obvious from Fleming.

There is nothing in Fleming that even remotely suggests instructing a user to install a device. The Examiner's conclusion of obviousness is classic hindsight. Nobody reading Fleming would give any thought at all to what happens when a device is not detected (other than doing nothing) without having first read the instant application. Fleming detects the presence of a hardware device connected to the system, but makes no provision for prompting the user to connect the device if it is determined that the device is not already connected, as in Claim 1. The Examiner has not made any showing of a motivation to modify Fleming apart from Applicants' own teaching. Absent such a showing, the rejection should be withdrawn.

Claims 9 and 19 are method and computer medium counterparts to the system of Claim 1. Claim 27 is directed to a system that includes a user interface that instructs a user to connect the hardware device if it is determined that the hardware device is not connected to the computer system. Claims 9, 19 and 27, therefore, are felt to distinguish patentably over Fleming for the reasons noted above for Claim 1. Claims 2-8, 10-16, 20-26 and 28-34 are also felt to distinguish patentably over Fleming (or Fleming in view of Nykanen) due to their dependence on Claims 1, 9, 19 and 27, respectively.

B. Ground For Rejection B (Claims 35-36) – Edelstein does not teach removing a driver if it is determined the operating system does not

Include a Windows Installer, or updating a driver if it is determined that the operating system does include a Windows Installer.

Claims 35 and 36 were rejected under Section 103 as being obvious over Fleming in view of Edelstein (6378128). The rejection is based on the assertion that Edelstein teaches determining if the computer operating system includes a Windows installer and then taking the claimed action in response to this determination.

Claim 35 recites:

determining if an operating system on the computer includes a Windows Installer service;

if it is determined that the operating system does not include a Windows installer service, then removing any driver for the device provided by the operating system and setting up the operating system to use a driver provided with the device; and

if it is determined that the operating system includes a Windows installer service, then updating any driver for the device associated with the Windows installer service with a driver provided with the device.

Claim 36, which is a computer medium counterpart to the method of Claim 35, contains similar limitations.

Edelstein teaches adding an intelligent install module to the Windows Installer to provide functionality for dynamically creating or modifying the install-set for installing an application program. Edelstein, column 6, lines 32-36. Edelstein does not make any determination that the operating system does or does not include a Windows installer. Rather, Edelstein assumes the Windows Installer exists in the operating system. It necessarily follows, therefore, that Edelstein does not take any action in response to any such determination. Specifically, Edelstein does not teach removing a driver if it is determined the operating system does not include a Windows Installer, or updating a driver if it is determined that the operating system does include a Windows Installer. Indeed, Edelstein doesn't have anything to do with device drivers.

The Examiner asserts that "operable to detect" at column 6, line 29 in Edelstein teaches determining that the operating system does not include a Windows Installer. The Examiner's assertion is not correct. The cited passage

refers to "a WINDOWS INSTALLER program module that is operable to detect and install a new application program module 136...." This passage doesn't say anything about determining that the operating system does not include a Windows Installer. Indeed, it is clear that the operating system does include a Windows Installer.

The Examiner asserts that "install a new application program module" at column 6, line 31 in Edelstein teaches removing a driver provided by the operating system. The Examiner's assertion is not correct. The cited passage refers to "a WINDOWS INSTALLER program module that is operable to detect and install a new application program module 136...." This passage doesn't say anything about removing a device driver or any other programming.

The Applicant respectfully submits that Edelstein really doesn't have any relevance at all to the subject matter of Claims 35 and 36. The rejection of Claims 35 and 36 should be withdrawn.

Respectfully submitted,

Steven R. Ormiston
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APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. A hardware driver install system used in conjunction with a computer system, said install system apparatus comprising:

means for determining if the hardware device is connected to the computer system;

means for instructing a user to connect the hardware device if it is determined that the hardware device is not connected to the computer system; and

means for installing a driver for the hardware device if it is determined that the hardware device is connected to the computer system.

2. The system of claim 1, further comprising:

means for determining if a default driver exists for the hardware device.

3. The system of claim 2, further comprising:

means for replacing the default driver with the driver for the hardware device if it is determined that the hardware device is connected to the computer system .

4. The system of claim 1, wherein the installing means further comprises:

means for acquiring the driver from a network source.

5. The system of claim 1, further comprising:

means for determining if there are a plurality of hardware devices connected to the computer system.

6. The system of claim 1, further comprising:

means for determining which of the plurality of hardware devices connected to the computer system are to be removed.

7. The system of claim 6, wherein said plurality of hardware devices determining means further comprises:

means for removing the plurality of hardware devices from a device object that are determined to be removed; and

means for removing any shortcut for the plurality of hardware devices that are determined to be removed from the computer system.

8. The system of claim 1, further comprising:

means for using a default install system of an operating system for the computer system when installing the driver for the hardware device.

9. A method for installing a driver for a hardware device on a computer system, the method comprising:

determining if the hardware device is connected to the computer system;

instructing a user to connect the hardware device if it is determined that the hardware device is not connected to the computer system; and

installing the driver for the hardware device if it is determined that the hardware device is connected to the computer system.

10. The method of claim 9, wherein the installing step further comprises:

determining if a default driver exists for the hardware device.

11. The method of claim 10, wherein the installing step further comprises:

replacing the default driver with the driver for the hardware device if it is determined that the hardware device is connected to the computer system.

12. The method of claim 9, wherein the installing step further comprises:

acquiring the driver from a network source.

13. The method of claim 9, further comprising:

determining if there are a plurality of device instances are connected to the computer system.

14. The method of claim 13, wherein the plurality of hardware devices determining step further comprises the step of:

determining which of the plurality of device instances connected to the computer system are to be removed.

15. The method of claim 14, further comprising:

removing the plurality of hardware devices from a device object that are determined to be removed; and

removing any shortcut for the plurality of hardware devices that are determined to be removed from the computer system.

16. The method of claim 9, further comprising:

using a default install system of an operating system on the computer system for installing the driver for the hardware device.

17-18.(cancelled)

19. A computer readable medium for a hardware driver install system, comprising:

logic for determining if the hardware device is connected to the computer system;

logic for instructing a user to connect the hardware device if it is determined that the hardware device is not connected to the computer system; and

logic for installing the driver for the hardware device if it is determined that the hardware device is connected to the computer system.

20. The computer readable medium of claim 19, further comprising:

logic for determining if a default driver exists for the hardware device.

21. The computer readable medium of claim 20, further comprising:

logic for replacing the default driver with the driver for the hardware device if it is determined that the hardware device is connected to the computer system.

22. The computer readable medium of claim 19, further comprising:

logic for determining if there are a plurality of hardware devices connected to the computer system.

23. The computer readable medium of claim 22, further comprising:

logic for determining which of the plurality of hardware devices connected to the computer system are to be removed.

24. The computer readable medium of claim 23, further comprising:

logic for removing the plurality of hardware devices from a device object that are determined to be removed; and

logic for removing any shortcut for the plurality of hardware devices that are determined to be removed from the computer system.

25. The computer readable medium of claim 19, further comprising:

logic for acquiring the driver from a network source.

26. The computer readable medium of claim 19, further comprising:

logic for using a default install system of an operating system on the computer system for installing the driver for the hardware device.

27. A hardware driver install system on a computer system, the install system apparatus comprising:

a decision mechanism that determines if the hardware device is connected to the computer system;

a user interface that instructs a user to connect the hardware device if it is determined that the hardware device is not connected to the computer system; and

a driver installer that installs a driver for the hardware device if it is determined that the hardware device is connected to the computer system.

28. The system of claim 27, wherein the decision mechanism further comprises:

logic configured to determine if a default driver exists for the hardware device.

29. The system of claim 28, wherein the driver installer further comprises:

logic configured to replace the default driver with the driver for the hardware device if it is determined that the hardware device is connected to the computer system.

30. The system of claim 27, wherein the decision mechanism further comprises:

logic configured to determine if there are a plurality of hardware devices connected to the computer system.

31. The system of claim 30, wherein the decision mechanism further comprises:

logic configured to determine which of the plurality of hardware devices connected to the computer system are to be removed.

32. The system of claim 31, wherein the decision mechanism further comprises:

logic configured to remove the plurality of hardware devices from a device object that are determined to be removed; and

logic configured to remove any shortcut for the plurality of hardware devices that are determined to be removed from the computer system.

33. The system of claim 27, wherein the driver installer further comprises:

logic configured to utilize a default install system of an operating system for the computer system.

34. The system of claim 27, wherein the driver installer further comprises:

logic configured to acquire the driver from a network source.

35. A method for installing a driver for a hardware device on a computer, the method comprising:

determining if an operating system on the computer includes a Windows installer service;

if it is determined that the operating system does not include a Windows installer service, then removing any driver for the device provided by the operating system and setting up the operating system to use a driver provided with the device;

if it is determined that the operating system includes a Windows installer service, then updating any driver for the device associated with the Windows installer service with a driver provided with the device;

determining if the hardware device is connected to the computer;

if it is determined that the device is not connected to the computer, then instructing a user to connect the hardware device to the computer; and

if it is determined that the device is connected to the computer, then installing the driver provided with the hardware device.

36. A computer readable medium for a hardware driver install system, comprising:

logic for determining if an operating system on the computer includes a Windows installer service;

logic for, if it is determined that the operating system does not include a Windows installer service, then removing any driver for the device provided by the operating system and setting up the operating system to use a driver provided with the device;

logic for, if it is determined that the operating system includes a Windows installer service, then updating any driver for the device associated with the Windows installer service with a driver provided with the device;

logic for determining if the hardware device is connected to the computer;

logic for, if it is determined that the device is not connected to the computer, then instructing a user to connect the hardware device to the computer; and

logic for, if it is determined that the device is connected to the computer, then installing the driver provided with the hardware device.